



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/804,087

03/19/2004

Juha R. Vallinen

59643.00396

7034

32294

7590

10/30/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3687

MAIL DATE

DELIVERY MODE

10/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,087	Applicant(s) VALLINEN ET AL.	
	Examiner VANEL FRENEL	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,17-20,27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-10, 17-20, 27-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/26/08 has been entered.

Notice to Applicant

2. This communication is in response to the RCE filed on 9/26/08. Claims 1, 5, 17, 27 and 28 have been amended. Claims 3-4, 11-16 and 21-26 have been cancelled. Claims 1-2, 5-10, 17-20, and 27-28 are pending.

Claim Rejections - 35 USC § 103

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be

Art Unit: 3687

negated by the manner in which the invention was made.

4. Claims 1-2, 5-10, 17-20 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al (2002/0072412) in view of Brown et al. (2003/0115203) and further in view of Egendorf (6,188,994).

Regarding claim 1, Young shows a method comprising: initiating a provision of a service for at least two parties (paragraph 4); verifying that each of the at least two parties is capable of paying for use of the service (paragraph 28); generating payment information (paragraphs 28-30); and charging for use of the service based on the payment information (paragraph 30).

Young discloses all the limitations above. Young does not explicitly disclose that the method having "by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information".

However, this feature is known in the art, as evidence by Brown. In particular, Brown suggests that the method having "by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information"(See Brown, Page 3, Paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system Young with the motivation of providing a link, or reference to a subscriber's data page may be sent to another party when the subscriber requests a connection with that party or the other

Art Unit: 3687

party requests a connection with the subscriber, while the subscriber and called party are connected, or after the connection (See Brown, Page 1, Paragraphs 0010-0011).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of

"and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service".

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" (See Egendorf, Fig.1; Fig.2; Col.3, lines 20-41; Col.4, lines 59-67 to Col.5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col.2, lines 1-3).

Regarding claim 2, Young shows the limitation wherein the step of initiating comprises initiating a provision of a game (abstract).

Art Unit: 3687

Regarding claim 5, Young shows defining the occurrence to be losing a game (paragraphs 4, 22).

Regarding claim 6, Young shows reserving for a party payment resources from a prepaid account of the party and including information of the reserved payment resources in the payment information (paragraph 25).

Regarding claim 7, Young shows reserving the payment resources in an online charging system (paragraph 26).

Regarding claim 8, Brown discloses the method further comprising charging the service to the reserved and returning unused payment"(See Brown, Page 3, Paragraph 0032).

Regarding claim 9, Brown discloses the method wherein the charging comprises charging the service to one of the at least two parties" (See Brown, Page 3, Paragraph 0032).

Regarding claim 10, Brown discloses the method further comprising sending at least one message in accordance with Session Initiation Protocol (See Brown, Page 2, Paragraph 0022).

Regarding claim 17, Young shows an apparatus, comprising: an enabler configured simultaneous provision of a service for at least two parties (paragraph 4); a verifier configured to verify that the at least two parties using the service are capable of paying for use of the service (paragraph 28); and a generator configured to provide payment information for the use of the service by the at least two parties for use in charging for the use of the service (paragraphs 28-30).

Young does not explicitly disclose that the apparatus having "by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information". However, this feature is known in the art, as evidenced by Brown. In particular, Brown suggests that the apparatus having "by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information"(See Brown, Page 3, Paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system Young with the motivation of providing a link, or reference to a subscriber's data page may be sent to another party when the subscriber requests a connection with that party or the other party requests a connection with the subscriber, while the subscriber and called party are connected, or after the connection (See Brown, Page 1, Paragraphs 0010-0011).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of "and wherein communicating the at least one message

Art Unit: 3687

between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service”.

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having ”and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service” (See Egendorf, Fig.1; Fig.2; Col.3, lines 20-41; Col.4, lines 59-67 to Col.5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col.2, lines 1-3).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of”and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service”.

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having ”and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for

Art Unit: 3687

paying for use of the service” (See Egendorf, Fig.1; Fig.2; Col.3, lines 20-41; Col.4, lines 59-67 to Col.5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col.2, lines 1-3).

Regarding claim 18, Young shows an apparatus further comprising: a charger configured to charge the service based on payment information (paragraph 26).

Regarding claims 19 and 20, Young shows an apparatus wherein the apparatus is one of a serving controller and an application server and the limitation wherein the apparatus is a game server (Fig. 1).

As per claim 27, Young discloses a computer program embodied on a computer readable medium, said computer program configured to control a processor to perform: initiating a provision of a service for at least two parties (paragraph 4); verifying that of the at least two parties is capable of paying for use of the service (paragraph 28).

Young does not explicitly disclose generating payment information by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the

Art Unit: 3687

payment information; and charging for use of the service based on the payment information.

However, this feature is known in the art, as evidenced by Brown. In particular, Brown suggests generating payment information by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information; and charging for use of the service based on the payment information "(See Brown, Page 3, Paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system Young with the motivation of providing a link, or reference to a subscriber's data page may be sent to another party when the subscriber requests a connection with that party or the other party requests a connection with the subscriber, while the subscriber and called party are connected, or after the connection (See Brown, Page 1, Paragraphs 0010-0011).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service".

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two

Art Unit: 3687

parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service” (See Egendorf, Fig.1; Fig.2; Col.3, lines 20-41; Col.4, lines 59-67 to Col.5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col.2, lines 1-3).

As per claim 28, Young discloses an apparatus, comprising: enabling means for enabling simultaneous provision of a service for at least two parties (paragraph 4); verifying means for verifying that the at least two parties using the service are capable of paying for use of the service (paragraph 28);

Young does not explicitly disclose generating means generating payment information for the use of the service by at least two parties for use in charging for the use of the service by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information.

However, this feature is known in the art, as evidenced by Brown. In particular, Brown suggests generating means generating payment information for the use of the service by at least two parties for use in charging for the use of the service by communicating at least one message between the at least two parties regarding a

Art Unit: 3687

principle for paying a fee for the use of the service and including the principle in the payment information (See Brown, Page 3, Paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system Young with the motivation of providing a link, or reference to a subscriber's data page may be sent to another party when the subscriber requests a connection with that party or the other party requests a connection with the subscriber, while the subscriber and called party are connected, or after the connection (See Brown, Page 1, Paragraphs 0010-0011).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service".

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" (See Egendorf, Fig.1; Fig.2; Col.3, lines 20-41; Col.4, lines 59-67 to Col.5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of

Art Unit: 3687

Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col.2, lines 1-3).

Response to Arguments

5. Applicant's arguments filed on 9/26/08 with respect to claims 1-2, 5-10, 17-20 and 27-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Shin whose telephone number is (571) 270-3276. The examiner can normally be reached on Monday to Friday, 10:30 am - 7:00 pm, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Gart can be reached on (571) 272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call

Application/Control Number: 10/804,087

Page 13

Art Unit: 3687

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/

Examiner, Art Unit 3687

October 21, 2008